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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/023,330

Applicant(s)

ROLLAT ET AL.

Examiner

Gina C. Yu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on December 4, 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): Obvious double patenting rejection.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 167-169, 171, 172, 174, 175, 177, 178, 180-182 and 185-308.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


SHENGJUN WANG
PRIMARY EXAMINER

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Continuation of No. 5:

Applicants state that a preamble is a limitation when one could not identify the scope of the claims without it. In response, the terms "shampoo" or "a hair styling" do not give any structural limitation to a composition. The terms merely convey how the composition to be used.

Applicants state that a preamble is a limitation when there is repetition of the language in the body of the claims. Applicants assert that the terms "reshapable hair styling composition" and "shampoo" are repeated in the body of the claims. Examiner asserts that any composition comprising at least surfactant and the methacrylic polymer recited in the composition obviously has the reshaping effect, since the property of the composition is inseparable from the composition.

Applicants also state that a preamble is a limitation when a review of the entirety of the record gives an understanding of what the inventors actually invented and intended to encompass by the claim. Applicants' assertion that the only intended invention is the particular hair product claimed is unpersuasive. In fact, the paragraphs [8] through [25] lists the possible use of the prior art methacrylic copolymer in shampoo or conditioner in the form of aerosol, emulsion, aerosol, mousse, gel, lotion, cream, or dispersion, hair rinses, permanent waving compositions, waving compositions, hair dye compositions, products to use before or after a hair dye treatment, products to use before or after a permanent waving treatment, and hair straightening compositions. These

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applications are all directed to the method of using the composition, and does not in anyway constitute a structural limitation to the claimed composition itself.

The present case should be distinguished from the facts in Corning Glass Works v. Sumitomo Electric U.S.A. Inc. See 9 U.S.P.Q. 2d 1962, 1965 (Fed. Cir. 1989). In that case, the court found that the term "optical waveguide" is a claim limitation because "not all core/cladding combinations" works as an optical waveguide. However, applicants do not even define what is necessarily present in the composition to be considered as a shampoo. For example, would an aqueous composition comprising an anionic surfactant or a liquid soap for hand meet the term "shampoo"? The term "abrasive article" in Kropa v. Robie was found to be a claim limitation because the "term calls forth a distinct relationship between the proportions of grain and resin comprising the article". In this case, however, there is no such distinction as to the terms "hair styling" or "shampoo" and the recited components. In both precedents, the terms in the preamble defined what the claimed subject matters were. The terms "shampoo" and "hair styling" do not, because they merely describe how the composition is used, rather than what constitutes the composition.

Applicants assert that the use of a surfactant to a methacrylic polymer in Yang is limited to the case where the methacrylic adhesive is formed. Examiner respectfully points out that there is no structural distinction between the claimed invention and the teaching of the prior art. Applicants' claim is not limited to any particular vehicle or the amount or type of the surfactants present in the prior art.

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With respect to the obviousness in modification of the weight range of the monomers of the polymers, applicants assert, "mere fact that an act is within the skill of a person of ordinary skill does not establish that there is a motivation to do so". In response, examiner respectfully points out that the court in In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record may be taken by the examiner if the facts are "capable of such instant and unquestionable demonstration as to defy dispute" (citing In re Knapp Monarch Co., 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In Ahlert, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." In this case, it is viewed that the examiner's conclusion is properly made because the adhesiveness of the polymer is affected by the adhesive monomer.

Applicants assert that Yang does not motivate one of ordinary person in the art to select N-butyl acrylate, 2-hydroxy ethyl acrylate, and 2-ethyl hexyl acrylate monomers. Applicants' assertion that there is no motivation to select these monomers from 19 possible choices is factually incorrect, because the reference in col. 2, lines 21 – 32 summarizes the prior art invention as an adhesive comprising "(a) 50-90 % by weight, preferably 70-90 % by weight n-butyl acrylate, (b) 10-50%, preferably 10-30% weight **2-hydroxy ethyl acrylate**, or **2-hydroxy ethyl methacrylate**, hydroxyl propyl acrylate monomer, or **mixtures thereof**, (c) optionally, co-polymerizable monomers". The reference provides specific teaching to use the claimed monomers.

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Applicants assert that “reshapable effect” is a functional limitation. While applicants cited In re Pearson in arguing that “where the claim recites an *intended use or property* that is distinguishable over the prior art, an obviousness rejection may not be appropriate (emphasis mine)”, examiner respectfully takes the position that the proposition of the court does not exactly support applicants’ statement. See 181 U.S.P.Q. 641, 644 (C.C.P.A. 1974). Rather, the court held that, for a recitation of an intended use or purpose of a composition to be considered as a claim limitation, it must define some characteristic not found in the prior art composition.

It seems quite clear to us that one of the compositions admitted to be old by the appellant would not undergo a metamorphosis to a new composition by labeling its container to show that it is a composition suitable for treating peanuts to avoid the formation of pops and unsound kernels. See In re Lemin, supra. The container would still contain the old composition. We do not mean to imply that terms which recite the intended use or a property of a composition can never be used to distinguish a new from an old composition. However, assuming their compliance with the definiteness requirement of the second paragraph of 35 U.S.C. 112, such terms must define, indirectly at least, some characteristic not found in the old composition.

The court there affirmed the Board’s decision to reject the composition claim because the prior art taught the calcium composition comprising small particles as claimed by applicants. Also in this case, the Yang reference teaches of the polymer claimed by applicants, it also teaches that it would have been obvious to combine the polymer with a surfactant.

In E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., the issue in that case was whether the claimed copolymer, as defined in part by various

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property parameters (measurements of comonomer content, density, and percent crystallinity), is new. The Du Pont Court there distinguished the case from Titanium Metals Corp. of America v. Banner which determined the issue of whether discovery of a new property of an old composition is patentable. See 778 F.2d 775, 227 USPQ 773_(Fed. Cir. 1985). As the Du Pont court noted, in Titanium, once the alloy disclosed in the prior art reference was determined to possess the structural limitations of the claim, the burden shifted to the applicants to show that the alloy disclosed in the reference did not possess the claimed property. See *Id.* Examiner takes the position that the facts of the present case is more close to the Titanium case, since the term “reshapable effect” merely connotes the property of the old composition when used in hair styling. The term “reshapable effect” is not in any way viewed as a property parameter of the claimed polymer to define the polymer or distinguish the polymer over the prior art.

With respect to the term “at least on conditioner”, examiner respectfully points out that the term is not limited any specific compound or how the conditioning agent is to be used.

Applicants assert that there is no motivation to use the Yang polymers in the Engel's skin compositions. The Engel reference teaches the use of adhesives in personal care products, specifically, in skin care compositions. While applicants assert that Engel needs not be modified because it already teaches compositions with hydrophobic coating, the argument is unpersuasive. Applicants also assert that the reference “teaches away” from combining with the

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Yang reference. Applicants state, "Engel et al. explains that it is desirable to have a nearly white adhesive and not a clear adhesive". However, the reference at the quoted paragraph merely teaches to use opacifying agents can be used to impart color, if desired. See [0051]. The reference in fact states, "it may be desirable to have a nearly white colored adhesive to provide color contrast between the adhesive and the undesirable materials". See Id. Adding a color to the adhesive is merely an option if the color contrast is desired. Nowhere in the reference does it teach against using a clear adhesive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner